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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,621	04/02/2004	Kia Silverbrook	HYC001US	9577
24011 7590 03/03/2010 SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA				
EXAMINER				
MOSSER, ROBERT E				
ART UNIT		PAPER NUMBER		
3714				
NOTIFICATION DATE		DELIVERY MODE		
03/03/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

pair@silverbrookresearch.com  
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### Office Action Summary

**Application No.**

10/815,621

**Applicant(s)**

SILVERBROOK ET AL.

**Examiner**

ROBERT MOSSER

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 32 and 40-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32 and 40-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on the 30<sup>th</sup> November 2009 has been entered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **32** and **40-43** are rejected under 35 U.S.C. 103(a) as being unpatentable over Seidman (US 5,080,364) in view of Silverbrook et al (US 6,457,883) in further view of Stangl (US 7,197,642).

Claim **32**: Seidman teaches competition system including the use of machine readable coded data printed on the label of a product and the verification of competition entry through the presentation of an award (*Seidman* Figure 2). The system of Seidman further teaches capturing interaction data from a barcode reading device indicating the reading of a barcode and affecting the entry into a competition through transmission of data to central data processing center responsive thereto (*Seidman* Figure 1, 2; Col 2:26-32, 2:61-63, 6:5-16; 35:).

Seidman is silent regarding the incorporation and transmission of a sensing device ID registered as being associated with the entrant, and product identifiers, however the related communication device of Silverbrook teaches the inclusion and transmission of a application alias ID, user ID, pen and pen ID registered as being associated with the entrant, and UPC product identifiers (*Silverbrook* Elm 65; Col 33:11-16; 35:34-36; 37:22-30). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the transmission of an application alias ID, a user ID, a pen and pen ID registered as being associated with the entrant, and the use of UPC product identifiers as taught by Silverbrook in the product entry of Seidman in order to determine the location, individual, and product associated with the entry and/or user specific context for the exchange of information.

The combination of Seidman and Silverbrook is silent regarding the association of actual and temporary communication addresses and the transformation between the temporary addresses and actual addresses to enable communication. However, the reference of Stangl teaches the utilization of temporary communications addresses and the transformation between the temporary addresses and actual addresses to enable communication to conceal the actual communication address of one party from another (*Stangl* Col 2:44-62). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the temporary communications address and address translation features of Stangl in the combination of Seidman and Silverbrook in order to enable communication to conceal the actual communication address of one party from another.

**Claims 40-41:** The combination of Seidman, Silverbrook, and Stangl does not explicitly teach limiting the number of messages communicated from the application to the user to a predetermined number of messages, however figure 2 of Seidman would implicitly allow for a predetermined maximum number of messages from the application to the user based on the flow chart presented therein. Hence this feature is understood as being implicitly provided for by the Seidman reference in the combination of Seidman, Silverbrook, and Stangl. As an alternative to the preceding and without any directed or inferred concession thereof it would have been additionally obvious to one of ordinary skill in the art at the time of invention to employ a predetermined limit the number of messages presented to the user from an application in the invention of Seidman because as disclosed by Seidman only a finite number of messages are

required to practice the invention and such would additionally limit the amount of bandwidth utilized by a user for a given session.

**Claim 42:** As cited above Seidman teaches the utilization of the UPC of a product will provide them with game entry, as presently and broadly claimed the details of the purchase would include the purchase itself required to obtain the UPC for game entry.

### ***Response to Arguments***

Applicant's arguments filed November 30<sup>th</sup>, 2009 have been fully considered but they are not persuasive.

In the third and forth full paragraphs of page 4 of the applicant's remarks the applicant discusses the recent amendments to claim 32 and in particular the registration of the sensing to device as being associated with the entrant. With reflection to this limitation it is noted that the prior art of Silverbrook teaches the registration of the sensing device with a particular user/entrant.

Continuing in the fifth full paragraph on page 4 the applicant generally alleges that the teachings of Seidman and Stangl could not be modified according to the teachings of Silverbrook as presented by the rejection of record and in view of the newly presented claim language.

Applicant's arguments of this paragraph fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

In the sixth paragraph on page 4 and continuing through the page 5, the applicant raises a specific challenge to the rejection of record under the applicant's proposition that the prior art of Seidman and Silverbrook fails to teach identifying any telecommunications address from the sensing device ID or receiving a message to be forwarded to the entrants communication address either directly or though the use of a temporary address. The claim elements directed to recognizing the entrants communication address and transferring information there between are incorporated though the inclusion of Stangl wherein Stangl teaches both the identification and concealment of telecommunications addresses to enable the communications between electronic network devices in a manner that conceals the actual communication addresses from each party involved in the exchange. Accordingly, claim limitations that the applicant argues as absent in the combination of Seidman and Stangl are provided for in the reference of Stangl incorporated into the same rejection

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As an alternative interpretation of the applicant's arguments presented in the paragraph bridging pages 4 and 5, the applicant appears to be arguing that the references of Seidman and Silverbrook allegedly do not readily lend to modification in

view of Stangl because the system and methods of Seidman and Silverbrook do not allegedly speak to the identification of a telecommunications address of the sensing device ID or forwarding information to the entrant's sensing device. Alternatively stated the applicant appears to alternatively argue that it would be non-obvious to modify an element of communication (broadly speaking) wherein the prior art references of Seidman and Silverbrook do not purportedly include the communication elements to be modified. It is respectfully submitted that both the prior art of Seidman and Silverbrook speak to the inclusion of communication from the transfer and validation of items by the player terminal (14) in combination with the central data processing (22) described in figures 1,2 and Col 4:10-38 of Seidman, to the network exchange of information elements including netpage elements of Silverbrook illustrated at least in part in figure 3 of the same. In combination the references of Seidman, Silverbrook, and Stangl teach the features of the invention as reflected in the pending claims.

### ***Conclusion***

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued

examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT MOSSER whose telephone number is (571)272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Supervisory Patent Examiner, Art  
Unit 3714

/R. M./  
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